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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/532,937

Filing Date: March 22, 2000

Appellant(s): HILD ET AL.

David England
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 12/22/2004.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

The rejection of claims 1, 2, 11, 12, 21 and 22 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

The rejection of claims 5, 15, 25, 32, 34 and 36 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

The rejection of claims 6, 7, 16, 17, 26 and 27 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

The rejection of claims 8, 18 and 28 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

The rejection of claims 9, 19, 29, 39, 42 and 45 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

The rejection of claims 10, 20 and 30 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

The rejection of claims 37, 38, 40, 41, 43 and 44 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

The rejection of claims 37, 40 and 43 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

The rejection of claims 38, 41 and 44 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

The appellant's statement in the brief that certain claims do not stand or fall together is not agreed with because Applicant states that claims 9, 9 and 29 stand rejected under 35 U.S.C. § 112, first paragraph when the rejection should be claims 9, 19 and 29 as previously stated in Final Office Action dated 06/21/2004.

(8) *ClaimsAppealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

5948061	Merriman et al.	9-1999
6401085	Gershman et al.	4-2002
6098081	Heidorn et al.	8-2000
6268856	Bruck et al.	7-2001

(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1, 2, 11, 12, 21 and 22 are rejected under 35 U.S.C. 102(e). This rejection is set forth in a prior Office Action, mailed on 06/21/2004.

Claims 5 – 10, 15 – 20, 25 – 30, 32, 34 and 36 – 44 are rejected under 35 U.S.C. 103(a).

This rejection is set forth in a prior Office Action, mailed on 06/21/2004.

Claims 9, 19, 29, 37, 38, 40, 41, 43 and 44 are rejected under 35 U.S.C. 112, first paragraph. This rejection is set forth in a prior Office Action, mailed on 06/21/2004.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 21 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The claims is rejected under 35 U.S.C. 112, first paragraph as failing to comply with the description requirement thereof since the claims introduce new matter not supported by the original disclosure. The original disclosure does not reasonably convey to a designer of ordinary skill in the art that applicant was in possession of the design now claimed at the time the application was filed. See *In re Daniels*, 144 F.3d 1452, 46 USPQ2d 1788 (Fed. Cir. 1998); *In re Rasmussen*, 650 F.2d 1212, 211 USPQ 323 (CCPA 1981).

Specifically, there is no support in the original disclosure of the teachings of a plurality of requested client properties being less than all available client properties found in the original discloser of the specification. Therefore, new subject matter will not be entered and the previous rejection still stands as restated below.

Claims 37, 40 and 43 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The claims is rejected under 35 U.S.C. 112, first paragraph as failing to comply with the description requirement thereof since the claims introduce new matter not supported by the original disclosure. The original disclosure does not reasonably convey to a designer of ordinary skill in the art that applicant was in possession of the design now claimed at the time the application was filed. See *In re Daniels*, 144 F.3d 1452, 46 USPQ2d 1788 (Fed. Cir. 1998); *In re Rasmussen*, 650 F.2d 1212, 211 USPQ 323 (CCPA 1981).

Specifically, there is no support in the original disclosure of the teachings of a plurality of requested client properties included in the list in the link element are less than all client properties that may be included in the list is found in the original discloser of the specification. Therefore, new subject matter will not be entered and the previous rejection still stands as restated below.

Claims 38, 41 and 44 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The claims is rejected under 35 U.S.C. 112, first paragraph as failing to comply with the description requirement thereof since the claims introduce new matter not supported by the original disclosure. The original disclosure does not reasonably convey to a designer of ordinary skill in the art that applicant was in possession of the design now claimed at the time the application was filed. See *In re Daniels*, 144 F.3d 1452, 46 USPQ2d 1788 (Fed. Cir. 1998); *In re Rasmussen*, 650 F.2d 1212, 211 USPQ 323 (CCPA 1981).

Specifically, there is no support in the original disclosure of the teachings of a inserted at least one of said plurality of client properties is less than all the plurality of requested properties included in the link element is found in the original discloser of the specification.

Therefore, new subject matter will not be entered and the previous rejection still stands as restated below.

Claims 9, 19 and 29 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The limitation of, “transmitting the request without at least one of the selected ones of the plurality of request client properties if the user indicates the selected ones of the plurality of requested client properties are not to be sent”, is not specifically found in the specification. The Applicant is suggested to add the missing step that states that the client properties are not mandatory. This would narrow the scope of the claim and would require further search and consideration **but** would overcome the rejection stated above.

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the a plurality of requested client properties being less than all available client properties must be shown or the feature(s). canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the plurality of requested client properties included in the list in the link element are less than all client properties that may be included in the list must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the inserted at least one of said plurality

of client properties is less than all the plurality of requested properties included in the link element must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 2, 11, 12, 21 and 22 are rejected under 35 U.S.C. 102(e) as being anticipated by Merriman et al. U.S. Patent No. 5948061 (hereinafter Merriman).

Referencing claim 1, Merriman teaches in a networked environment, a method for designating client properties comprising:
receiving a link element associated with a server, that link element including a plurality of requested client properties, (e.g. col. 3, line 24 – col. 4, line 11 & col. 5, line 33 – col. 7, line 43);

selecting said link element to request a document identified by the link element to be transmitted to a client, (e.g. col. 3, line 24 – col. 4, line 11 & col. 5, line 33 – col. 7, line 43); inserting at least one of said plurality of requested client properties into a request so as to allow customization of the requested document identified by the link element based on the inserted at least one of said plurality of requested client properties, (e.g. col. 3, line 24 – col. 4, line 11 & col. 5, line 33 – col. 7, line 43).

Referencing claim 2, Merriman teaches said plurality of requested client properties is contained within an attribute of said link element, (e.g. col. 3, line 24 – col. 4, line 11).

Claims 11, 12, 21 and 22 are rejected for similar reasons as stated above.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5, 15, 25, 32, 34 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Merriman (5948061) in view of Gershman et al. (6401085) (hereinafter Gershman).

As per claim 5, Merriman does not specifically teach said plurality of requested client properties includes at least one property that is a wild card. Gershman teaches said plurality of requested client properties includes at least one property that is a wild card, (e.g. col. 21 – 22). It would have been obvious to one skilled in the art at the time the invention was made to combine Gershman with Merriman because it would be more efficient for a user to utilize this very common utility as a wild card, (i.e. *.doc, hyper\$ism, ect.), to broaden a field of search.

As per claim 34, Merriman does not specifically teach at least one of the plurality of requested client properties is associated with hardware characteristics of the client. Gershman teaches at least one of the plurality of requested client properties is associated with hardware characteristics of the client, (e.g. col. 58, lines 21 – 29). It would have been obvious to one skilled in the art at the time the invention was made to combine Gershman with Merriman because having hardware as at least one requested client property could aid in the transmission, storage and compatibility of the system that is transmitting the client information. For example, if a client wanted to download information after accessing a link and the user didn't have a fast enough transmission median, the server from which the download is coming from would know this from the transmitted hardware information that was requested from the client, therefore the server could make the necessary changes to make sure that the download transmits successfully without error or deny the client altogether.

Claims 14, 15, 24, 25, 34 and 36 are rejected for similar reasons as stated above.

Claims 6, 7, 16, 17, 26 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Merriman (5948061) in view of Heidorn et al. (6098081) (hereinafter Heidorn).

As per claim 6, Merriman teaches all that is similar with reference to claim 1 but does not specifically teach said plurality of requested client properties includes at least one property that is designated as a mandatory property and at least one property that is an optional property. Heidorn teaches said plurality of requested client properties includes at least one property that is designated as a mandatory property and at least one property that is an optional property, (e.g. col. 7, lines 18 – 27, *"link bound attributes and mandatory attributes"*). It would have been obvious to one skilled in the art at the time the invention was made to combine Heidorn with Merriman because it would be more efficient for a system to have at least one property that the system could use to identify a user. If there is no property for a user then the user does not exist in the system.

As per claim 7, Merriman does not specifically teach said step of inserting comprises the

steps of:

selecting each one property from said plurality of requested client properties included in the link element; and

determining whether said each one property is available to be transmitted. Heidorn teaches said step of:

inserting comprises the steps of selecting each one property from said plurality of requested client properties included in the link element, (e.g. col. 3, line 56 – col. 4, line 34, “*soft hyperlink*”); and

determining whether said each one property is available to be transmitted, (e.g. col. 3, line 56 – col. 4, line 34). It would have been obvious to one skilled in the art at the time the invention was made to combine Heidorn with Merriman because it would be more efficient if the system error check to see if the system or user had specific property data to transmit to the system. If the system didn’t have this function it could cause error in the system and build a property list or table that has incorrect property information about a user making the system flawed.

Claims 16, 17, 26 and 27 are rejected for similar reasons as stated above.

Claims 8, 18 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Merriman (5948061) in view of Heidorn (6098081) in further view of Gershman (6401085).

As per claim 8, Merriman and Heidorn do not specifically teach said step of selecting further comprises expanding a wildcard property. Gershman teaches said step of selecting further comprises expanding a wildcard property, (e.g. cols. 21 – 22). It would have been obvious to one skilled in the art at the time the invention was made to combine Gershman with Merriman and Heidorn because it would be more efficient for the system to be able to utilize

the function of a wild card, (i.e. the ability of have a symbol to stand for different files and/or letters).

Claims 18 and 28 are rejected for similar reasons as stated above.

Claims 9, 19, 29, 39, 42 and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Merriman (5948061) in view of Heidorn (6098081) in further view of Gershman (6401085) in further view of Bruck et al. (6268856) (hereinafter Bruck).

As per claim 9, as closely interpreted by the Examiner, Merriman does not specifically teach prompting a user whether to transmit the selected ones of the plurality of requested client properties if it is determined that at least one of the selected ones of the plurality of requested client properties is available to be transmitted; and transmitting the request without at least one of the selected ones of the plurality of request client properties if the user indicates the selected ones of the plurality of requested client properties are not to be sent.

Heidorn teaches said step of determining further comprises prompting to transmit said each one property, (e.g. col. 3, line 56 – col. 4, line 34 & col. 7, lines 18 – 27), but does not teach said step of determining further comprises prompting a user whether to transmit. Gershman teaches said step of determining further comprises prompting a user whether to transmit, (e.g. col. 3, lines 14 – 29 & col. 43, line 45 – col. 44, line 14). Bruck teaches if it is determined

that at least one of the selected ones of the plurality of requested client properties is available to be transmitted, (e.g. col. 10, lines 51 – 67 & col. 13, lines 29 – 49); and transmitting the request without at least one of the selected ones of the plurality of requested client properties if the user indicates the selected ones of the plurality of requested client properties are not to be sent, (e.g. col. 10, lines 51 – 67 & col. 13, lines 29 – 49). It would have been obvious to one skilled in the art at the time the invention was made to combine Gershman, Heidorn and Bruck with Merriman because make a system have more versatility for a user that would want to utilize the system but would not want to divulge certain information that would be considered private and/or vital to a user, (i.e. cookies that might have credit card information, social security number). Having this option would make a user more likely to utilize the invention for it security reasons.

Claims 19, 29, 39, 42 and 45 are rejected for similar reasons as stated above.

Claims 10, 20 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Merriman (5948061) in view of Heidorn (6098081) in further view of Bruck (6268856).

As per claim 10, as closely interpreted by the Examiner, Merriman does not specifically teach

terminating the request if it is determined that at least one of the selected ones of the plurality of requested client properties is not available to be transmitted and the at least one of the selected ones of the plurality of requested client properties that is not available to be

transmitted is a mandatory property. Bruck teaches determined that at least one of the selected ones of the plurality of requested client properties is not available to be transmitted, (e.g. col. 10, lines 51 – 67 & col. 13, lines 29 – 49).

Heidorn teaches the step of terminating the request if a mandatory property and an optional property are not available to be transmitted, (e.g. col. 3, line 56 – col. 4, line 34, “*link bound attributes and mandatory attributes*”). It would have been obvious to one skilled in the art at the time the invention was made to combine Heidorn and Bruck with Merriman because of similar reasons stated above. Furthermore, if the user didn’t have the information that is mandatory for the system to function then the system would not be able to execute its functions therefore, making the inventions function useless.

Claims 20 and 30 are rejected for similar reasons as stated above.

Claims 37, 38, 40, 41, 43 and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Merriman (5948061) in view of Gershman (6401085).

As per claim 37, Merriman does not specifically teach the plurality of requested client properties included in the list in the link element are less than all client properties that may be included in the list. Gershman teaches the plurality of requested client properties included in the list in the link element are less than all client properties that may be included in the list, (e.g. col. 46, lines 44 – 60, “*and discarding the less relevant ones*”). It would have been obvious to one skilled in the art at the time the invention was made to combine Gershman

with Merriman because discarding the less relevant interests provides an increase in the quality of the document.

Claims 38, 40, 41, 43 and 44 are rejected for similar reasons as stated above.

Response to Arguments

Applicant's arguments filed 03/29/2004 have been fully considered but they are not persuasive.

In the remarks, Applicant argues in substance that nothing in the cited portion of Merriman discloses or suggests receiving a link element from the server including a plurality of requested client properties, inserting at least one of these requested client properties into a request and using the at least one requested client properties to customize the requested document.

As to part 1, Examiner would like to draw the Applicant's attention to column 5, lines 45 – 49 of Merriman. In which, Merriman discussed the use of a promotional advertisement to a new user to gather information about him or herself. Once the user selects an advertisement to view, (a link element), information about the user is gathered because of the type of advertisement that is presented and from other advertisements gathered by the system. This can be interpreted in to the broad limitations of claims 1, 11, and 21.

Furthermore, when reviewing a reference the applicants should remember that not only the specific teachings of a reference but also reasonable inferences which the artisan would have logically drawn therefrom may be properly evaluated in formulating a rejection. *In re Preda*, 401 F. 2d 825, 159 USPQ 342 (CCPA 1968) and *In re Shepard*, 319 F. 2d 194, 138 USPQ 148 (CCPA 1963). Skill in the art is presumed. *In re Sovish*, 769 F. 2d 738, 226 USPQ 771 (Fed. Cir. 1985). Furthermore, artisans must be presumed to know something about the art apart from what the references disclose. *In re Jacoby*, 309 F. 2d 513, 135 USPQ 317 (CCPA 1962). The conclusion of obviousness may be made from common knowledge and common sense of a person of ordinary skill in the art without any specific hint or suggestion in a particular reference. *In re Bozek*, 416 F.2d 1385, 163 USPQ 545 (CCPA 1969). Every reference relies to some extent on knowledge of persons skilled in the art to complement that which is disclosed therein. *In re Bode*, 550 F. 2d 656, 193 USPQ 12 (CCPA 1977).

In the remarks, Applicant argues in substance that none of the cited references either alone or in combination disclose or suggest the recitations of at least the dependent claims set out above. Furthermore, the motivation is a motivation based on “subjective belief and unknown authority”, the type of motivation that was rejected by the Federal Circuit in *In re Sang-su Lee*. The Office Action does not point to any specific portion of the cited references that would induce one of skill in the art to combine the cited references as suggested in the Office Action.

As to part 2, in response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In the remarks, Applicant argues in substance that the limitation of a plurality of requested client properties being less than all available client properties is disclosed in the specification. More specifically, "... a method by which a Web server can indicate which device, user, software, and network properties can it use when generating personalized content for the requesting user.", "can indicate which device, user software, and network properties are required for it to generate any meaningful content for the requesting user...".

As to part 3, Examiner would like to draw the Applicant's attention to the claim language from which this argument derives from, "plurality of requested client properties being less than all available client properties". In which it is interpreted that the requested client properties have to be less than all available client properties. The cited areas of the Applicant's application indicate that it could use all the network properties that are given to

the Web server. Therefore, rejection still stands along with drawing Objections for they also fall under the same reasons as stated above.

Applicant's arguments with respect to claims 5 – 10, 12, 15 – 20, 22, 25 – 30, 32, 34 and 36 – 44 have been considered but are moot in view of the new ground(s) of rejection.

(11) Response to Argument

In the Arguments, Applicant states in substance that Merriman at least, does not teach the limitations of “receiving a link element associated with a server, the like element including a plurality of requested client properties; and inserting at least one of said plurality of requested client properties into the request so as to allow customization of the requested document identified by the link element based on the inserted at least one of said plurality of requested client properties, which can be found in claims 1, 2, 11, 12, 21 and 22.

As to the first argument, the Examiner would first like to address the multiple interpretations that can be derived from the Applicant's claim language. As to the “receiving a link element associated with a server, the like element including a plurality of requested client properties,” the Applicant does not disclose, what a link element could be nor does the Applicant state in the independent claims what a plurality of requested client properties could be. This would leave one to interpret this as broadly as when a server transmits a web link with in a web page that with the protocols of HTTP and TCP/IP, the user's IP address or cookies can be sent when a web link is selected. It is well known in the art that cookies are utilized in web

services to give servers information about previously accessed web pages and properties about the user so the web server can download a reselected web page faster than before.

As to "inserting at least one of said plurality of requested client properties into the request so as to allow customization of the requested document identified by the link element based on the inserted at least one of said plurality of requested client properties"

This would leave one to interpret this as broadly as when a user clicks on a web link, the user's IP address is sent as the source address and a cookie is transmitted with the request as is common in HTTP and TCP/IP headers in web page accessing. The insertion of an IP address as a source address, to the server, so the server can communicate back with the user and transmitted cookies to the web server can download a web page faster, can be interpreted as the requested document be customized because once the request is processed by the web server, the server would need to know where to send the information and therefore, utilizing the information that was sent, the source address, to now put into the destination address so the information that is sent can be received by the user's browser. More can be interpreted into this example such as the cookies having browser type information, Netscape or Internet Explorer, as is common in the computer networking art, so the web server can send the proper code for that specific browser type.

Examiner would now like to address the misinterpretation of the section discussed in Merriman. Applicant states that the section of Merriman, column 3, lines 24 – 63 can be interpreted as "a user selects a hyperlink presented on a browser, for example, Netscape, and the browser retrieves all of the information available at the web site, for example, a requested document, except for certain advertising objects. Once all the available information is

obtained, the browser transmits a message 23 to an advertising server that uses the information provided in the message 23 to attack an advertisement to the requested information (requested document) that may be tailored for the specific user or computer. Thus, the advertisement, not the requested information, is tailored to the user/computer based on the information provided in the message 23.”

If the Applicant looks at how the claim language is stated, “receiving a link element associated with a server, the link element including a plurality of requested client properties.” Attention should be given to the phase “requested client properties,” which is past tense. This would make one believe that a request was initially sent for a document or the like with information about a client and what is returned or “received” is a link element associated with a server, such as a banner, that has the “requested client properties” included in the element.” The properties that are initially sent include: the user’s IP address, a cookie if the browser is cookie enabled and stores cookie information, a substring key indicating the page in which the advertisement to be provided from the server is to be embedded, and MIME header information indicating the browser type and version, the operation system of the computer on which the browser is operating and the proxy server type. As seen further down column 3, one sees that the messages 24 containing the object such as a banner advertisement to the user’s browser 16 using the HTTP protocol, which is another type of link element that can be interpreted into the broadly interpreted claim language given by the Applicant, also contained within the HTTP message is a unique identifier for the advertiser’s web page appropriate for the advertisement. The unique identifier is also found in a cookie as will now be described below.

In column 5, starting at line 10, one can see different scenarios that one can come across when using the prior art of Merriman. One of which is if a user's browser is cookie enabled but no cookie is detected. In which case the request is from a new user so a user identification must be assigned to the user and the user's new identification number will be transmitted back to the user's browser to write a cookie containing that unique identification number on the user's local drive for future accesses to affiliate sites. The cookie instruction is transmitted back with the advertisement messages 24. This would leave one to believe that a unique identification number is sent with cookies with the message 23, column 3, lines 40 – 47 and sent back in message 24 as stated previously in column 3, lines 54 – 63. Therefore, it can be interpreted that the identification number along with the cookie is the user's requested properties that are sent to and from an advertising server and then possibly to the advertiser's web site.

Merriman also teaches "inserting at least one of said plurality of requested client properties into the request so as to allow customization of the requested document identified by the link element based on the inserted at least one of said plurality of requested client properties," as previously touch upon above. This information can be found in column 3, line 64 to column 4, line 11, et seq. Where it is stated As part of the "click through" process, when the user clicks on the banner or other advertising objects displayed by the user's browser 16, the user's browser again transmits a message to the ad server. The Ad server notes the address of the computer of the browser (or any other identifier such as a cookie or a digital signature) that generated the message 23 and transmits back the URL of the advertiser's web page so that the user's web browser 16 generates a message 26 to contact the advertiser's web site 18.

This would be interpreted into the claim language as inserting at least one of said plurality of requested client properties into the request. The request for a document the prior art is teaching would be an advertisement. This advertisement is generated, or requested document is customized, to fit the properties that the user has to specifically target information or products the user could be interested in. Even though the ad server obtains from a database, information about the user, column 5, line 50 to column 6, line 11, the information can only be found by the server with the use of the cookies and/or the identification number associated with the user. It can be interpreted that through the use of the identification number and cookies that are transmitted back and forth, the requested client properties, a document or advertisement is customized to fit the properties given to the server with the request.

Further down in the Applicant's arguments it is stated "The cited portion of Merriman set out above discusses a server that sends a link back to the browser including an IP address for a node running an advertiser server process as well as information about the page on which the advertisement will be displayed and a user's browser that transmits a message to the advertising server.

Although this is true the Applicant does not discuss the identification number nor the cookie that could also be transmitted back to the browser.

The link discussed in Merriman does not appear to specify requested client properties, but appears to specify a server property and web page information. Nothing in the cited portion of Merriman discloses or suggests receiving a link element from the server including a plurality of requested client properties, inserting at least one of these requested client

properties into a request and using the at least one requested client properties to customize the requested document.

This is also not true. As can clearly be seen as stated above, Merriman teaches that when the user clicks on a banner, or link element, information about the user is required for the ad server to process information and send the user an advertisement that is tailored to the users wants and needs as linked to the cookie and identification number sent with the request.

In fact, it appears as if the message 23 of Merriman includes information stored in a user profile or cookie and that the information in this user profile or cookie is dumped into the message 23. As stated above and even with the Applicant, the information such as cookie, which does have an identification number, is used in the message to identify a user and the cookie is sent back to the user with either a link element or utilized for a customized advertisement for the user.

For these reasons stated above it is clear that the prior art of Merriman reads on the Applicant's claim language.

In the Arguments, Applicant argues in substance that claims 6, 16 and 26 were amended to include the recitations of claims 1, 11 and 21. Furthermore, Heidorn fails to provide the missing teachings. Thus, claims 6, 16 and 26 are patentable for at least the reasons discussed above with respect to claims 1, 11 and 21.

As to the second argument, Examiner would like to draw the Applicant's attention to the first response where they can find similar reasons why Merriman teaches the limitations of claims 1, 11 and 21. Furthermore, Applicant's arguments fail to comply with 37

CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

In the Arguments, Applicant argues in substance that the dependent claims are patentable at least per the patentability of the independent base claims 1, 11 and 21 from which they depend.

As to the third argument, Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

In the Arguments, Applicant argues in substance that, with respect to claims 1, 11 and 21, nothing in Merriman discloses or suggests a link element including a plurality of requested client properties or inserting at least one of the requested client properties into a request as recited in claims 7, 17 and 27. Heidorn does not provide the missing teachings.

As to the forth argument, Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

In the Arguments, Applicant argues in substance that nothing in the cited portion of Bruck discusses prompting a user for permission to transmit information as recited in claims 9, 19 and 29. Also the cited portion of Gershman discusses prompting the user to input information of interest to the user, but does not prompt the user for permission to transmit information requested in a link as recited in claims 9, 19 and 29. Furthermore, nothing in the cited references discloses or suggests “transmitting the request without at least one of the selected ones of the plurality of requested client properties if the user indicates the selected ones of the plurality of requested client properties are not to be sent.”

As to the fifth argument, Examiner would like to point to the Final Rejection dated 06/21/2004, in which Bruck is not relied on to teach the limitation of “prompting a user for permission to transmit information as recited in claims 9, 19 and 29. Gershman is used for this limitation as previously stated in the Final Office Action dated 06/21/2004. As cited in the sections stated in the Final Office Action, column 43, line 61 to column 44, line 14, “the profile gateway server 1720 receives all requests for profile information, whether from the user himself or merchants trying to provide a service to the user. The profile gateway server is responsible for ensuring that information is only given out when the profile owner specifically grants permission. Also, if the Applicant would draw their attention to Figure 21 of Gershman, it would be well apparent that there are items that have permissions that are set by the user. For example, in Figure 21, the user selects the radio button to which information should others have permission to and whether one is asked or not. Furthermore, in column 39, lines 25 – 44 it is apparent that Gershman teaches prompting a user for permission as to what should be transmitted to other users, as can be interpreted by the broad claim language,

“An Egocentric Interface is a user interface crafted to satisfy a particular user's needs, preferences and current context. It utilizes the user's personal information that is stored in a central profile database to customize the interface. The user can set security permissions on and preferences for interface elements and content. The content integrated into the Egocentric Interface is customized with related information about the user. When displaying content, the Egocentric Interface will include the relationship between that content and the user in a way that demonstrates how the content relates to the user.” As can be seen there are multiple ways to interpret the claim language of the Applicant's invention, therefore the combination of Merriman, Heidorn, Gershman and Bruck read on the claim language of the Applicant's invention. Applicant is also reminded when reviewing a reference the applicants should remember that not only the specific teachings of a reference but also reasonable inferences which the artisan would have logically drawn therefrom may be properly evaluated in formulating a rejection. In re Preda, 401 F. 2d 825, 159 USPQ 342 (CCPA 1968) and In re Shepard, 319 F. 2d 194, 138 USPQ 148 (CCPA 1963). Skill in the art is presumed. In re Sovish, 769 F. 2d 738, 226 USPQ 771 (Fed. Cir. 1985). Furthermore, artisans must be presumed to know something about the art apart from what the references disclose. In re Jacoby, 309 F. 2d 513, 135 USPQ 317 (CCPA 1962). The conclusion of obviousness may be made from common knowledge and common sense of a person of ordinary skill in the art without any specific hint or suggestion in a particular reference. In re Bozek, 416 F.2d 1385, 163 USPQ 545 (CCPA 1969). Every reference relies to some extent on knowledge of persons skilled in the art to complement that which is disclosed therein. In re Bode, 550 F. 2d 656, 193 USPQ 12 (CCPA 1977).

As for the limitation of “transmitting the request without at least one of the selected ones of the plurality of requested client properties if the user indicates the selected ones of the plurality of requested client properties are not to be sent,” Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

In the Arguments, Applicant argues in substance that nothing in the cited references discloses or suggests that at least one of the plurality of client properties is designated as a mandatory property, thus, it also follows that none of the cited references discloses or suggests terminating the request based on the mandatory property no being available to be transmitted as recited in claims 10, 20 and 30.

As to the sixth argument, Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

In the Arguments, Applicant argues in substance that nothing in the cited portion of Gershman discloses or suggests including in a list in the link element, less than all client properties as recited in claim 37. Accordingly, in addition to being patentable as depending

form a patentable base claim, Appellants respectfully request reversal of the rejection with respect to claims 37, 40 and 43 for at least these additional reasons.

As to the seventh argument, Applicant is asked to draw their attention to the cited section of Gershman that are stated above, more specifically Figure 21. In which one can see that one can select less than all client properties to be given permission for other users to view.

In the Arguments, Applicant argues in substance that the Final Office Action does not even address the specific recitations of these claims Appellants submit that nothing in the cited combination discloses or suggests the recitations of claim 38, but merely states that they are rejected for similar reasons to claim 37.

As to the eighth argument, Applicant is asked to draw their attention to the cited section of Gershman that are stated above, more specifically Figure 21. In which one can see that one can select less than all client properties to be given permission for other users to view. This can be interpreted as client properties are less than all the plurality of requested properties.

In the Arguments, Applicant argues in substance that there is also no proper motivation to combine the cited references in the manner suggested in the Final Office Action. Each of the cited references include different uses of links, networks, and the like, and a § 103 rejection may not be supported simply by throwing these disparate arrangements of teachings together in an ad hoc fashion, as these proposed changes would fundamentally change the functionalities of the inventions described in the cited references.

As to the ninth argument, Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references. Furthermore, as can be seen in numerous areas of the cited art, there are other reasons, not stated by the Examiner, that would give reasons to combine the prior arts of record.

In the Arguments, Applicant argues in substance that the rejection of claims 37, 40 and 43 under 35 U.S.C. § 112 first paragraph is not new matter for at least the reason that it can be found in page 4, line 10 to page 5, line 11, Figure 4B, page 12, lines 15 – 20 and the summary of the invention.

As to the tenth argument, Applicant cites these portions of their specification: Summary of the Invention, “An object of the present invention is to provide, within a networked environment, a method by which a Web server can indicate which device, user, software, and network properties can it use when generating personalized content for the requesting user. Another object of the present invention is to provide a method by which a Web server can indicate which device, user, software, and network properties are required for it to generate any meaningful content for the requesting user...”.

There is no part in this section of the specification that reads a plurality of requested client properties included in the list in the link elements are less than all client properties that may be included in the list.

Figure 4B description, "The server may need to indicate to the client browser that the server that provides a particular linked document is capable of customizing the content or format of that document according to the client as long as the document request includes information about the hardware device, platform or application software, or user preferences. To do this, the server may include an additional attribute (PROFILEATTRS) with the link element listing the properties that the referenced server can use to customize the referenced document."

Specification, page 12, lines 15-20, "Again there would be no need for a Web Server to indicate which properties it can use to customize the referenced document, if all of the available properties were indicated."

With these combinations of cited areas that are pointed out, with reference to a list that holds the client properties in a link element, by the Applicant, the 112 rejection on claims 37, 40 and 43 are to be withdrawn.

In the Arguments, Applicant argues in substance that the subject matter of dependent claims 38, 41 and 44 is not new matter and that claims 38, 41 and 44 are in compliance with 35 U.S.C. § 112 first paragraph, for areas stated in background of the invention and page 4, lines 1 – 8 of the specification.

As to the eleventh Argument, the Applicant states these sections of the specification. "Therefore, a need exists for a method and system that allows Web servers to indicate which device, user, software, and network properties can it use to generate personalized content for the requesting user. The Web server also needs to indicate which properties are

actually required for it to generate any meaningful content at all. Using this mechanism, the client can optionally query the user for permission before including the requested information in the request. **Using the mechanism, the client furthermore can save bandwidth by only transmitting information that the server will use.”**

Background of the Invention, page 4, lines 1-8. The Summary of the Invention further recites:

“Yet another object of the present invention is to provide a method for reducing the amount of network bandwidth consumed to transmit device, user, software, and network information that is not used by the Web server.”

Although these sections say nothing about how one inserts at least one of said plurality of client properties is less than all the plurality of requested properties included in the link element, from the previous Argument stated by the Applicant, the 112 first paragraph rejection on claims 38, 41 and 44 is to be withdrawn.

In the Arguments, Applicant argues in substance that claims 9, 19 and 29 are compliant with 35 U.S.C. § 112 first paragraph rejection and support for this can be found in the flowchart of Figure 5.

As to the twelfth argument, the Examiner would like to point out that there is no flowchart in Figure 5, let alone a Figure 5. What is in the Drawings are Figures 5A, 5B and 5C, none of which have a flowchart. It is assumed that the Applicant meant Figure 7, for it does consist of a flowchart. After careful review of the possible outcomes of the flowchart and what is disclosed in the specification it can be derived that the limitation of claims 9, 19

and 29 that state, "transmitting the request without at least one of the selected ones of the plurality of request [sic] client properties if the user indicates the selected ones of the plurality of requested client properties are not to be sent," is taught, therefore, the 112 first paragraph rejection on claims 9, 19 and 29 are to be withdrawn.

In the Arguments, Applicant argues in substance that the limitation of "the plurality of requested client properties being less than all available client properties," is clearly illustrated in the Figures. More specifically, Figure 5A illustrates the PROFILEATTRS, which designates a list of client properties that may be provided to the server from which the document is requested. As illustrated therein and described in the corresponding text, the PROFILEATTRS of Figure 5A only includes one client property, Hardwarecharacteristics 346. As stated in the specification, "[t]he list 345 includes only one property... Additional properties may be included in the list 345 by separating them with a semi-colon." See Specification, page 13, lines 9 – 12.

As to the thirteenth argument, there is no description linked to a figure that teaches the plurality of requested client properties being **less than all available client properties**. All that is suggested is that if more properties are to be applied, a semi-colon would separate them. Nothing states that the Hardwarecharacteristics 346 are less than all available client properties for this example given by the Applicant. What also can be assumed is that Hardwarecharacteristics 346 is the only available client property, therefore the requested client properties cannot be less than all available client properties since there is only one that

is available. Nor is it disclosed that in the Figures selects less than all available client properties.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David E. England whose telephone number is 571-272-3912. The examiner can normally be reached on Mon-Thur, 7:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A. Wiley can be reached on 571-272-3923. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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